

Application No.: 09/872,451
Reply to final Office Action of: April 19, 2007

33. (Original) A communication method as described in Claim 27 wherein said standard electronic mail protocol is substantially compliant with the SMTP protocol (Simple Mail Transport Protocol).

REMARKS

This amendment is responsive to the office action dated April 19, 2007. Claims 1-28 and 30-33 are pending and stand rejected. By this preliminary amendment, Claims 9 and 22 are amended and claims 10 and 23 are canceled, without prejudice to overcome the 35 U.S.C. Section 112 rejections. The scope of all the remaining rejected claims 1-9, 11-22, 24-28 and 30-33 are amended to overcome the 35 U.S.C. 103 rejections. Reconsideration of the rejected claims is respectfully requested.

Objection to the Specification

The abstract of the disclosure is objected to because the abstract is not limited to a single paragraph within the range of 50 to 150 words. Application submits an abstract with 150 words.

35 U.S.C. § 112 Rejections

In paragraph 5 of the office action, the Examiner indicated that claims 9, 10, 22, and 23 contain the trademark/trade names Bluetooth and Mobitex. The Examiner indicates that where a trademark or trade name is used in a claim as a limitation to identify or describe particular material or product, the claim does not comply with the requirements of 35 U.S.C. Section 112, second paragraph. Respectfully, Applicant has amended claims 9 and 22 by deleting the reference to Bluetooth and has canceled claims 10 and 23, without prejudice.

35 U.S.C. § 103 Rejections

In paragraph 7 of the office action, the Examiner indicates that claims 1-28 and 30-33 are rejected under 35 U.S.C. Section 103 (a) as unpatentable over Watanabe et al. (U.S. Patent No. 6,850,757) and Mousseau et al. (U.S. Patent Application Publication No. 2002/0120696). Respectfully, Applicant requests the Examiner to reconsider his rationale for combining the

references based on the standard set by the Supreme Court for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” But, that standard is not controlling. Instead the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether **the improvement is more than the predictable use of prior art elements according to their established functions.**

The Supreme Court in *KSR* also stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that **each of its elements was independently known in the prior art.**

The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court **to look to interrelated teachings of multiple patents;** the effects of demands known to the design community or present in the market place.

Further, the Supreme Court stated in *KSR* that:

The Court [in *United States v. Adams*, 383 U.S. 39, 51-52 (1966)] relied upon the corollary principle **that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.**

Applicants respectfully submit what Watanabe admits that the purpose of his system, in particular, his “notifications apparatus” is simply so that the “user can know of the arrival of the electronic mail at the predetermined electronic mail address, even when he/she is away from his/her office.” Simply receiving a notification on a user’s cell when the user is at a remote location cannot be equated to receiving a subset of the email, which allows the user to view the contents of the email. Moreover, Mousseau et al. (filed in the same time frame as Watanabe)

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teach a system and method of pushing "user-selected data items from a host system to a user's mobile data communication device upon detecting the occurrence of one or more user-defined event triggers." Mousseau et al., do not teach that the data items are automatically pushed from the host system to the user's mobile device. If the user in Watanabe is not even aware if he or she has received an email, how can he or she select a subset of the email to be sent to his or her own mobile device. Applicants respectfully submit that the two references cited by the Examiner at best show "**elements**" that are "**independently known in the prior art.**" In addition, both Watanabe and Mousseau et al., as demonstrated above, demonstrate that the combination would be nonobvious because each reference "**teaches away from combining certain known elements.**" The improvement claimed by the pending claims "**is more than the predictable use of prior art elements according to their established functions.**" For these reasons alone, the Examiner is requested to allow the claims.

By this preliminary amendment, claims 1 and 27 are amended to provide further specificity to emphasize the distinctions from the asserted art.

Conclusion

Applicants respectfully requests the Examiner to consider the amendments and legal reasoning urged here and to allow this application. In the event the Examiner requires further specificity to distinguish the asserted art, he is respectfully requested to call the undersigned to resolve any issues that remain before allowing this application to pass to issue.

Respectfully submitted,

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